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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/241,825	02/01/1999	MARK LYTE	933.001USR	9200

7590

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EXAMINER

LILLING, HERBERT J

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/241,825	LYTE, MARK	
	Examiner	Art Unit	
	HERBERT J. LILLING	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 23-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 23-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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In view of the remand by the Board of Appeals and Interferences filed on July 31, 2003, PROSECUTION IS HEREBY REOPENED. The following office action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


Supervisor Michael Wityshyn
Art Unit 1651

Michael G. Wityshyn
Supervisory Patent Examiner
Technology Center 1600

DETAILED ACTION

1. Claims 1-2 and 23-42 are pending in this application.

2. **Reissue claims 32-42**

The rejection of claims 32-42 under 35 U.S.C. 251 **has been withdrawn** based on the following reconsideration of the issues.

Reissue claims 32-42 are directed to never-before claimed subject matter, namely a method for “harvesting the by-products of enhanced growth of bacteria or viruses...” (Emphasis added.) Accordingly, claims 32-42 are directed to a separate invention. Support for this separate invention is found in the patent disclosure. See for example, column 4, lines 27-28; column 7, lines 22-33; and column 15, line 31 to column 16, line 7. Therefore, reissue claims 32-42 are claiming the same invention disclosed in the original patent which newly claimed subject matter is not any ground of rejection under 35 U.S.C. 251. Further, adding a disclosed, but unclaimed invention (e.g., new embodiment or specie) via reissue was expressly approved by the Federal Circuit in *In re Amos*, 21 USPQ2d 1271 (Fed. Cir. 1991) and *In re Doyle*, 63 USPQ2d 1161 (Fed. Cir. 2002).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2 and 23-42 are rejected under 35 U.S.C. 102(a) as anticipated by Giunta et al.

Giunta et al clearly anticipates the claims especially in view of the Growth Curves as noted in Figure 2 which clearly teaches that the catecholamine employed is the same one as claimed which is dopamine. The results indicate that depending upon a number of factors clearly indicates that dopamine will suppress the growth of *Staphylococcus aureus* which is a Gram-positive bacteria as shown in Figure 2 (top graph for Dopamine black triangle) for claim 1 as well as enhance the growth as shown in Figure 2 (top graph for Dopamine black rectangle) for claims 23-25 and 37-42. The results of the study indicated that there was a growth of the dopamine which was collected or at least analyzed that is within the scope of the term "harvested" in accordance with Figure 1 part 5 of the instant application whereby the growth of the bacteria, CFU (colony forming units) was harvested.

or, in the alternative,

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 23-42 are rejected under 35 U.S.C. 103(a) as obvious over
Giunta et al.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1,148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The reference, Giunta et al is considered to teach each of the claimed inventions especially in view of the disclosure pertaining to Figure 2 as well as Figure 1, which shows an increase. The claims are drawn to acting "directly on the growth" for claim 1 and "introduction of an effective amount of a catecholamine to the host medium" which requirements are considered to be met by the reference. However, if there are any process differences, these process differences would have been prima facie obvious in view of the disclosure by Giunta et al. absent unexpected or unobvious process steps.

The reference does not disclose epinephrine or norepinephrine as one of the catecholamines employed in the reference. It is considered that in view of the Giunta et al bacterial study for the addition of "catecholamines" which upon oxidation give rise to active oxidation intermediates as indicated on page 301 second column lines 9-15 which includes reference 22 by Giunta. As noted on page 303, ref 22 discloses "epinephrine" which is one of the catecholamines cited by Giunta et al. Thus, it would have been prima facie obvious to one of ordinary skill in the art to employ epinephrine for dopamine with the reasonable expectation to obtain similar results absent unexpected or unobvious results for the claimed species.

4. Claims 23-31 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

The remand from the Board of Appeals and Interferences (BPAI) was based on a consideration of Ex Parte Eggert et al, Appeal No 2001-0790 (BPAI) May 29, 2003) for examiner's answer of December 21, 2000.

In the "SUMMARY" on page 29 of the Examiner's Answer lists 6 items characterizing the § 251 rejections. Items 2-6 are in effect a single ground of rejection based on recapture of subject matter surrendered during prosecution of the original application. Item 1 asserts a separate ground of rejection, namely that the reissue claims fail to claim the same invention disclosed in the original patent as required by 35

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U.S.C. 251. Accordingly, the rejection of claims 23-31 under 35 U.S.C. 251 is deemed to be based on the following two grounds:

- (1) Recapture of subject matter surrendered during prosecution of the original application.
- (2) Failure to claim the same invention disclosed in the original patent.

Both grounds are addressed as follows:

Background:

In the original application, original claims 1-23 were directed to stimulating the growth of vectors and cell cultures and living organisms using a chemical compound such as catecholamine derivatives. Claims 1-23 were rejected based on prior art in the initial Office action of September 25, 1992. Applicant's response to the initial Office action, canceled original claims 1-23, and added the following groups of claims:

(A) claims 24 and 25 directed to “**suppressing the growth** of Gram-positive bacteria” using “an effective amount of a catecholamine” [ultimately the patented subject matter];

(B) claims 26-28 directed to **suppressing the growth** of Gram-positive bacteria using “an effective blocker of catecholamine receptor sites”; and

(C) claims 29-33 directed to “**diagnosing the presence** of Gram-negative organisms in a culture from a patient.”

None of the added claim groups (A)-(C) replaced the claimed subject matter of originally filed claims 19-23 (Element 1 below). Ultimately, claim group (B) and claim group (C) were canceled from the original application pursuant to restriction requirements.

The group (A) claims were issued.

Original patent claims 1 and 2 are directed to, group (A), “**suppressing the growth of Gram-positive bacteria**” (emphasis added) using “**an effective amount of a catecholamine.**”

By contrast, reissue claims 23-31 are directed to “**enhancing the growth** of bacteria or viruses...” (Emphasis added) using “an effective amount of a catecholamine.” Similar to reissue claims 23-31, the original application included claims 19-23 directed to “**stimulating the growth** of vectors and cell cultures and living organisms...” (emphasis added) using a chemical compound such as “catecholamine derivatives.”

In summary, the following “Elements” were present in the original application for the patent:

Element 1: Stimulating the growth of vectors and cell cultures and living organisms. - Canceled after the first action rejection based on art.

Element 2: Suppressing the growth of Gram-positive bacteria using “an effective amount of a catecholamine” – the patented claims.

Element 3: Suppressing the growth of Gram-positive bacteria using “an effective blocker of catecholamine receptor sites...” - A non-elected group of canceled claims.

Element 4: Diagnosing the presence of Gram-negative organisms in a culture from a patient - A non-elected group of canceled claims.

Recapture Analysis:

Reissue claims 23 -31:

Element 1 was included in the original application only in claims that were canceled in their entirety to define over the prior art and obtain allowance of the original patent. Therefore, the claim subject matter to **Element 1** - “**Stimulating** the growth of vectors and cell cultures and living organisms...” was surrendered in the prosecution of the original patent.

Reissue claims 23 - 31, directed to “**enhancing** the growth of bacteria or viruses,” contains **Element 1**. The “vectors” and “living organisms” of Element 1 cover the bacteria¹ and viruses² of reissue claims 23 -31. It is further noted that reissue claims 23 -31 are as broad in scope as the Element 1 claims that were canceled from the original patent application, and that reissue claims 23 -31 have not been materially narrowed in any respect.

The **recapture rule bars** the patentee from acquiring, through reissue, claims that are

(a) in all respects (of the same scope as), or

(b) broader in scope than, those claims canceled from the original application.

Accordingly, the rejection of reissue claims 23-31 as an improper recapture of subject matter surrendered during prosecution of the original application.

The facts of the recapture rejection are **not** analogous to the facts in *Ex Parte Eggert et al*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003):

Eggert is not on point here. In *Eggert*, the relied-upon limitation (for patentability) was not omitted in its entirety, but rather was broadened. Accordingly, the Board found the claims to

¹ Note, for example, that the patent Abstract refers to “organisms such as bacteria.”

² See original application dependent claim 21.

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escape the recapture doctrine. In the present instance, the relied upon "limitation" is omitted in its entirety. The suppressing the growth of Gram-positive bacteria using an effective amount of a catecholamine, which was relied upon to obtain the grant of the patent is omitted in the rejected claims.

5. **No claim is allowed.**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner Lilling whose telephone number is 571-272-0918** and **Fax Number** is (703) 872-9306 or SPE Michael Wityshyn whose telephone number is 571-272-0926. Examiner can be reached Monday-Thursday from about 5:30 A.M. to about 3:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Information regarding the status of an application may be obtained from the Patent Application information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit **1651**
January 11, 2006



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